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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,992	12/12/2000	Anuj Jain	ERIC P12549	3370

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EXAMINER

NAJJAR, SALEH

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 03/23/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,992

Applicant(s)

JAIN, ANUJ

Examiner

Saleh Najjar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-32, 35-48 and 51-68 is/are rejected.
- 7) ☒ Claim(s) 33-34, 49-50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. This action is responsive to the preliminary amendment filed on March 2, 2004. Claims 26, 36, 42, 52, 57, and 63 were amended. Claims 26-68 are pending. Claims 26-68 represents a method, system and product for controlling inclusion of email content.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-32, 36-40, 42-48, 52-56, 57-61, and 63-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogilvie et al., U.S. Patent No. 6,487,586.

Ogilvie teaches the invention as claimed including a self-removing email, verified or designated as such by a message distributor for the convenience of a recipient (see abstract).

As to claim 26, Ogilvie teaches a method of controlling retransmission of email message content in an email message by a recipient of the email message, the method comprising:

inserting control information into a first email message to control retransmission of the email message content in a second email message originating from a recipient of the first email message, ,without deleting the recipient's copy of the first e-mail message (see col. 5-6; col. 7, lines 1-10, Ogilvie discloses removal indicators using control code 210 and removal code 208 which automatically remove an attachment included in an email message and discusses that the client may have time to copy the email to disk before sending a reply of forwarding the email message); and transmitting the first email message to the recipient (see fig. 2; col. 5, Ogilvie discloses that a removal code, 208, and 210 facilitate removal of some or all portions of a message sent and retransmitted by the receiver in either a reply or forward email function).

As to claim 27, Ogilvie teaches the method of claim method of claim 26, wherein the second email message comprises a reply message, and wherein the control information controls inclusion of the email message content in the reply message (see col. 6, lines 5-15, Ogilvie discloses that the control information controls the inclusion of email content in a reply message).

As to claim 28, Ogilvie teaches the method of claim 26, wherein the second email message comprises a forwarding message, and wherein the control information controls inclusion of the selected portions of the email message content in the forwarding message (see col. 5-6).

As to claims 29-30, Ogilvie teaches the method of claim 26, wherein the control information causes at least a portion or the entire of the email message content to be excluded from the second email message (see col. 5, line 33, Ogilvie discloses that the control code can specify portion of or all of the message content to be deleted).

As to claim 31, ,Ogilvie teaches the method of claim 26, further comprising selecting a portion of the email message content to be excluded from the second email message, and wherein the control information causes the selected email message

content in the first email message to be excluded from the second email message (see col. 5-6).

As to claim 32, Ogilvie teaches the method of claim 31, wherein selecting a portion of the email message content to be excluded from the second email message comprises receiving a keyword entered by a user and selecting portions of the email message content based on the keyword entered by the user (see col. 5, line 31; col. 9, lines 1-3; col. 13, Ogilvie discloses that keyword data in the message information can also be used to control the content deletion of portions or all the message).

Claims 36-40, 42-48, 52-56, 57-61, 63-67 do not teach or define any new limitation above claims 26-32 and therefore are rejected for similar reasons.

5. Claims 35, 41, 51, 62, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie further in view of Foldare et al., U.S. Patent No. 6,311,210.

Ogilvie teaches the invention substantially as claimed including a self-removing email, verified or designated as such by a message distributor for the convenience of a recipient (see abstract).

As to claim 35, Ogilvie teaches the method of claim 26.

Ogilvie does not explicitly teach the limitation wherein the control information causes at least a portion of the email message content to be excluded from the second email message based on the identity of the recipient.

However, Foldare teaches a method and system for determining the portions of email content to send to receiving devices based on identity of the receiving devices (see abstract). Foldare teaches causing at least a portion of the email message content to be excluded from the second email message based on the identity of the recipient (see col. 3, Foldare discloses that some portion of the email content may be embodied in the case of a PDA receiver).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ogilvie in view of Foldare so that email content delivered is based on the receiver's identity. One would be motivated to do so to accommodate the receiving capability of different devices used to receive electronic mail.

Claims 41, 51, 62, and 68 do not teach or define any new limitations above claim 35 and therefore are rejected for similar reasons.

6. Claims 33-34, and 49-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Applicant's arguments filed March 2, 2004 have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that in Ogilvie, the self removing code never controls retransmission of the messages without deleting the recipient's copy of the email message as required by claim 26, instead, it permanently deletes the email message content upon occurrence of a trigger. The applicant further argues that the above features may occur but based on a trigger in Ogilvie.

In response, Ogilvie discloses removal indicators using control code 210 and removal code 208 which automatically remove for instance an attachment included in an email message and discusses that the client may have time to copy the email to disk before sending a reply or forwarding the email message, whether there is a trigger of time involved is irrelevant since the disclosure still reads on applicant's claim language (see col. 5-6; col. 7, lines 1-10).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saleh Najjar whose telephone number is (703) 308-7613. The examiner can normally be reached on Monday-Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ario Etienne*, can be reached on (703) 308-7562. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The fax number for the After-Final correspondence/amendment is

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(703) 746-7238. The fax number for official correspondence/amendment is (703) 746-7239. The fax number for Non-official draft correspondence/amendment is (703) 746-7240.

A handwritten signature in black ink, appearing to read 'Saleh Najjar', written in a cursive style.

Saleh Najjar

Primary Examiner / Art Unit 2157